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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/818,771	03/14/1997	MOJTABA MIRASHRAFI	002784.P001	9980

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06/18/2002

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT

PAPER NUMBER

2665

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/818,771

Applicant(s)

MIRASHRAFI ET AL.

Examiner

Steven HD Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,11,13-19,21-25,29 and 30 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-4,6-9,11,13-19,21-25,29 and 30 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As claims 29-30, A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Response to Amendment

2. The Declaration filed on 3/12/2001 under 37 CFR 1.131 is sufficient to overcome the Simmons reference because the applicant does not claim the same invention as disclosed in the Simmons and Markowitz (USP 6311185).
3. This action is in response to the amendment filed on 3/12/2002. Claims 5, 10, 12, 20, 26-28 and 31-32 have been canceled and claims 1-4, 6-9, 11, 13-19, 21-25 and 29-30 are pending in the application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 24-25 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Haserodt (USP 6031836).

As claim 24, Haserodt discloses a bridge server (Fig 1, Ref 104) for receiving a request for content which targets a network server (Fig 1, 105); the bridge server 104 marks up the request and returns to the user for resubmitting (Fig 1, Ref 1, Fig 2 discloses a server 104 for receiving a request for content of a network server 105 from user 113; *the server 104 generates a marked up request* form for transmitting to the user 113; allowing the user 113 to resubmit the request the marked up content to server 104); See col 3, lines 55 to col 4, lines 60.

As claim 25, Harerodt discloses a bridge server (Fig 2, Ref 104) removing the marked up content after receiving a resubmitted request and forwarding the request to the server (Fig 2,

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Ref 105, the server removed the requested data from the marked up form and forwards the requested data to the server 105); See col 3, lines 55 to col 4, lines 60.

As claim 29, Haserodt discloses in Fig 2, a client including a control logic for transmitting a request that target the server 105 and retransmitting the marked up request after receiving a mark up form which marked up by a bridge server 104; (See col 3, lines 55 to col 4, lines 60, the bridge server marked up the requested into a markup form to forward to client).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 11, 17-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoff (USP 5822539).

As claim 1, Van Hoff discloses a bridge server "Fig 2, Ref 118" for receiving a requested information from a client for targeting a network server "Fig 2, Ref 104" and attaching additional content "Fig 2, Ref 120 for merging the additional information into the requested information" into a requested information for transmitting to the user "Fig 2, Ref 102". Van Hoff does not disclose a step of determining if addition content is required for the requested before receiving the content information from the targeting server. However, Van Hoff discloses a step of checking for additional information based on the receiving information from the targeting server. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention

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was made to apply a step of determining if addition content is required for the requested before receiving the content information from the targeting server into Van Hoff's method and system. The motivation would have been to reduce the delay time and improve the throughput of a server.

As claim 2 and 4, Van Hoff discloses a step of determining if any addition contents are associated with the remote information server, then selecting an addition content to relay to the user (Fig 2, Ref 120 for determining if any documents are related to the requested information, if yes, selecting the addition information for merging into the document from the server 104).

As claim 3, Van Hoff discloses a step of sending an additional content without altering from requested information (It's implicitly shown by Van Hoff because Van Hoff does not disclose a step of altering).

As claim 11 and 17-18, Van Hoff disclose an addition information comprising hyperlink to identify the additional content information (See Fig 4).

As claim 19, Van Hoff discloses a bridge server "Fig 2, Ref 118" for receiving a request for information of targeted server "Fig 2, Ref 104", determining if any addition contents are associated with the remote information server, then selecting an addition content to relay to the user (Fig 2, Ref 120) and adding the additional information into requested information to provide to the user (Fig 2, Ref 102; See col 4, lines 58 to col 6, lines 63). Van Hoff does not disclose a step of determining if addition content is required for the requested before receiving the content information from the targeting server. However, Van Hoff discloses a step of checking for additional information based on the receiving information from the targeting server. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made

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to apply a step of determining if addition content is required for the requested before receiving the content information from the targeting server into Van Hoff's method and system. The motivation would have been to reduce the delay time and improve the throughput of a server.

As claims 21, Van Hoff discloses information being mark or tag by hyperlink such as URL to allow the user to retrieve the addition information (Fig 4).

8. Claim 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Haserodt as applied to claim 29 above, and further in view of Rondeau (USP 5850433).

As claim 30, Haserolt does not disclose the claimed invention. However, Rondeau disclosed a client system which transmits another request upon receiving an identifier of addition content from a server "Fig 1, Ref 28"; (a client clicks on the telephone icon to talk to the telephone 22 for addition content).

Since, Rondeau suggests a method of embedding the telephone number into a mark up page. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a telephone number into a web page as addition content for allowing a user to contact with an agent for obtaining more information as disclosed by Rondeau into Harserolt's communication system. The motivation would have been to prevent the human error.

9. Claims 6-9 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoff as applied to claims 1 and 19 above, and further in view of Rondeau (USP 5850433).

As claims 6-9 and 22, Van Hoff fails to disclose the claim invention. Rondeau discloses the additional content information comprising an option to make a phone call by allowing a user to click on the icon (Fig 2, Ref 54) to make a phone call via the network to a PSTN handset (Fig

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1, Ref 22) and the addition content such as telephone number must be marked by the access server for returning to the user in a form such as icon or button.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a database server which includes a telephone icon as disclosed by Rondeau into a server's Van Hoff. The motivation would have been to reduce the amount of time required to place a telephone to one of provider.

10. Claims 13-16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoff as applied to claims 1 and 19 above, and further in view of Haserodt (USP 6031836).

As claims 13-16 and 23, Van Hoff does not disclose the claimed invention. However, in the same field of endeavor, Haserodt a bridge server (Fig 1, Ref 104) for receiving a request for content which targets a network server (Fig 1, 105); the bridger server 104 marks up the request and returns to the user for resubmitting (Fig 1, Ref 1, Fig 2 discloses a server 104 for receiving a request for content of a network server 105 from user 113; the server 104 generates a mark up request form for transmitting to the user 113; allowing the user 113 to resubmit the request the marked up content to server 104) for establishing a telephone call; See col 3, lines 55 to col 4, lines 60.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a step of marking up the request for transmitting to the client and allowing the client to resubmit the request as disclosed by Haserodt into Van Hoff's communication system. The motivation would have been to allow a client to contact with an agent in real time.

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Response to Arguments

11. Applicant's arguments filed 9/4/2001 have been fully considered but they are not persuasive.

In response to page 5, the applicant states that Haserodt does not disclose the bridge server marks up a step of a marked up form. In reply, Haserodt discloses a server 104 upon receiving a requested form a client; the server will generate a marked up form for transmitting to the client so that the user can enter more information to resubmit it to the server 104 (See Fig 2).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Steven H. D. Nguyen
9/15/02